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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/880,151 | 06/13/2001 | Joseph M. Cannon | 51-49-7 | 7432 |

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Docket Administrator Agere Systems Inc.
P.O. Box 614
Berkeley Heights, NJ 07922-0614

| EXAMINER |
|---|
| PEREZ GUTIERREZ, RAFAEL |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2683 | 5 |

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

| Application No. | Applicant(s) |
|---|---|
| 09/880,151 | Cannon et al. |
| **Examiner** | **Art Unit** |
| Rafael Perez-Gutierrez | 2683 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *Jun 13, 2001*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1, 3-8, 23, 24, and 29-45* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1, 3-8, 23, 24, 29-38, and 42* is/are rejected.

7) ☒ Claim(s) *39-41 and 43-45* is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *Jun 13, 2001* is/are a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

### *Priority*

1. Applicant has complied with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120.

### *Information Disclosure Statement*

2. The information disclosure statement submitted on June 13, 2001 has been considered by the Examiner and made of record in the application file.

### *Preliminary Amendment*

3. The preliminary amendments filed on June 13, 2001 have been entered in the application file. Note to Applicant: Newly added **claims 1-17** were respectively renumbered **29-45**. The dependencies were corrected in accordance with the above-mentioned renumbering. The present Office Action is based upon said renumbering.

### *Drawings*

4. The drawings are objected to because of the following minor informality: On **figure 4**

**step 402**, replace "RECEICE" with --RECEIVE--. A proposed drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Objections***

5. As briefly explained above, the numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered **claims 1-17** have been renumbered **29-45**.

6. **Claims 23, 24, and 40** (as renumbered) are objected to because of the following informalities:

a) **Claims 23 and 24** are dependent on canceled **claim 21**; and

b) On **line 1** of **claim 40**, delete "," after "wherein".

Appropriate correction is required.

For purposes of applying prior art, claims 23 and 24 were considered as dependent on claim 29.

***Claim Rejections - 35 U.S.C. § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 1 and 29-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over

**McCarthy (U.S. Patent # 5,373,548)** in view of **Bauer (U.S. Patent # 5,406,617)**.

Consider **claim 1**, McCarthy clearly shows and discloses a cordless telephone (figure 1) comprising:

a base unit 10, including a paging mechanism (i.e., duplex radio transceiver 16 and microprocessor (MCU) 22) (figure 1); and

a portable handset 20, including a loudspeaker 40 (alerting mechanism) responsive to the paging mechanism (i.e., duplex radio transceiver 16 and microprocessor (MCU) 22) (figure 1 and column 3 lines 8-52).

However, McCarthy does not specifically shows or discloses that at least one of the base unit 10 and the portable handset 20 includes a page adjusting mechanism to affect an alerting signal output from the loudspeaker 40 (alerting mechanism) based on a condition.

Bauer clearly shows and discloses a cordless telephone (i.e., base unit 12 and telephone/intercom handset 14) (figures 2 and 3) with an additional intercom unit 10 (page adjusting mechanism) (figure 1) where the base unit 12, when triggered by the intercom unit 10 (page adjusting mechanism), causes a ring (alerting) signal at the telephone/intercom handset 12, distinct from the telephone ring signal employed for telephone usage, to be outputted from speaker 52 (alerting mechanism) to announce the intercom page (condition) (figures 1-3 and column 4 line 50 - column 5 line 4). Since Bauer teaches a method and system to alert a cordless telephone handset user to a condition other than a normal call by altering the ring of a cordless telephone handset, it would have been obvious to a person of ordinary skill in the art at the time

of the invention to employ the distinctive ring approach taught by Bauer in the cordless telephone system of McCarthy to identify an out-of-range condition.

Consider **claims 29-37**, McCarthy further discloses a method of outputting an alerting signal in a cordless telephone handset 20, comprising the steps of:

sensing a condition (i.e., received signal strength indication related to a signal from duplex radio (wireless) transceiver 36) related to a location of the handset 20; and

outputting the alerting signal based on the sensed condition (received signal strength compared to a threshold for potential out-of-range condition (i.e., location of the handset being sensed relative to duplex radio (wireless) transceiver 16 in corresponding cordless telephone base unit 10)) (figure 1 and column 3 lines 8-52).

McCarthy does not specifically discloses that a characteristic of the alerting signal is affected based on the sensed condition.

Bauer clearly shows and discloses a cordless telephone (i.e., base unit 12 and telephone/intercom handset 14) (figures 2 and 3) with an additional intercom unit 10 (figure 1) where the base unit 12, when triggered by the intercom unit 10, causes a ring (alerting) signal at the telephone/intercom handset 12, distinct from the telephone ring signal employed for telephone usage (e.g., by changing the duration, volume, tonal quality, or the like of the ring (alerting) signal), to be outputted from speaker 52 (alerting mechanism) to announce the intercom page (condition) (figures 1-3 and column 4 line 50 - column 5 line 4). Since Bauer teaches a method and system to alert a cordless telephone handset user to a condition other than a

normal call by altering the ring of a cordless telephone handset, it would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the distinctive ring approach taught by Bauer in the cordless telephone system of McCarthy to identify an out-of-range condition.

***Double Patenting***

9. Applicant is advised that should **claims 38 and 42** be found allowable, **claims 23 and 24** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. **Claims 1 and 3-8** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claims 1-5, 9, and 11** of **U.S. Patent No. 6,269,257 B1**. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

a) **claim 1** of U.S. Patent No. 6,269,257 B1 essentially claims the same subject matter as **claims 1 and 8** in the present application;

b) **claim 8** of U.S. Patent No. 6,269,257 B1 essentially claims the same subject matter as **claims 1 and 3** in the present application;

c) **claim 11** of U.S. Patent No. 6,269,257 B1 essentially claims the same subject matter as **claims 1 and 4** in the present application;

d) **claims 2 and 3** of U.S. Patent No. 6,269,257 B1 essentially claims the same subject matter as **claims 1 and 5** in the present application;

e) **claim 2 and 4** of U.S. Patent No. 6,269,257 B1 essentially claims the same subject

matter as **claims 1 and 6** in the present application; and

f) **claims 2 and 5** of U.S. Patent No. 6,269,257 B1 essentially claims the same subject matter as **claims 1 and 7** in the present application.

12. **Claims 23, 24, 29, 30, 34, 38, and 42** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claims 10 and 12** of **U.S. Patent No. 6,269,257 B1** in view of **McCarthy (U.S. Patent # 5,373,548)**.

Consider **claims 23, 24, 29, 30, 34, 38, and 42**, claims 10 and 12 of U.S. Patent No. 6,269,257 B1 essentially claim the same subject matter except that the sensed condition is related to a location of the handset.

McCarthy clearly discloses a method of outputting an alerting signal in a cordless telephone handset 20, comprising the steps of:

sensing a condition (i.e., received signal strength indication) related to a location of the handset 20; and

outputting the alerting signal based on the sensed condition (received signal strength compared to a threshold for potential out-of-range condition) (figure 1 and column 3 lines 8-52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to recognized, based on the teachings of McCarthy, that the sensed condition in claims 10 and 12 of U.S. Patent No. 6,269,257 B1 is in relation to the location of cordless telephone handset.

*Allowable Subject Matter*

13. **Claims 39-41 and 43-45** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including any correction(s) to any objection(s) made above as well as all of the limitations of the base claim and any intervening claims.

14. Since allowable subject matter has been indicated, Applicant is encouraged to submit formal drawings in response to this Office Action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

*Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Inagami (U.S. Patent # 4,884,294) discloses a portable cordless telephone set for outputting various discrimination sounds with simple circuit construction;

Ohayon (U.S. Patent # 5,952,918) discloses a recovery mode feature for wireless telephones and remote units.

16. Any response to this Office Action should be **faxed to** (703) 872-9314 **or mailed to**:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**Hand-delivered responses** should be brought to

Crystal Park II
2021 Crystal Drive
Arlington, VA 22202
Sixth Floor (Receptionist)

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, William G. Trost IV can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.

*Rafael Perez-Gutierrez*
R.P.G./rpg

RAFAEL PEREZ-GUTIERREZ
PATENT EXAMINER

WILLIAM TROST
SUPERVISORY PATENT EXAMINER
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October 30, 2002